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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,963	01/14/2004	Eran Baru	937/1	8183

7590 11/30/2006  
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EXAMINER

EDELL, JOSEPH F

ART UNIT PAPER NUMBER

3636

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/759,963	Applicant(s) BARU, ERAN	
	Examiner Joseph F. Edell	Art Unit 3636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 16-19 and 23-37 is/are pending in the application.  
4a) Of the above claim(s) 36 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-19 and 23-25 is/are rejected. 26-35
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to. *EC* 11/27/06
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Newly submitted claims 36 and 37 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons:

Invention of claims 16-18 and 23-35 and invention of claim 26 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination is associated with a chair by retrofitting the chair, and, in addition, need not have a seat connector affixed to the second end of the chassis. The subcombination has separate utility such as locking onto a chair having a base without a feet assembly.

Invention of claims 16-18 and 23-35 and invention of new claim 37 are related as a method of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the method as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different method (MPEP § 806.05(f)). In the instant case the method can be used to make a materially different product wherein the appendage is formed at the same as time as the chair, i.e. the appendage is not retrofitted to a chair.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 36 and 37 are withdrawn from consideration as being directed to a non-elected invention: See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the seat connected locked onto the central support column below the seat and above the feet assembly must be shown or the feature(s) canceled from the claim(s). Please note, Figure 3 does not show a feet assembly. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

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replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

3. Applicant is advised that should claims 29 and 30 be found allowable, claim 30 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,697,668 to Chao.

Chao discloses an appendage that includes all the limitations recited in claims 16-18. Chao shows an appendage having a monitor support structure 42 (see Fig. 3), a chassis 1 with a first end on which the monitor support structure is positioned and a second end, a seat connector 113,114 (Fig. 1) having a first end affixed to the second end of the chassis and a second end affixed to a central support column 13 wherein the chassis includes at least one arcuate and a pair of parallel tubular, elongated support rails, and the seat connector includes a locking mechanism capable of locking the seat connector onto the central support column below a seat and above a feet assembly (if the bolt were to include feet to add support to the chair).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 16-19, 23-25, 27, and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT Publication WO 99/04670 to Baru in view of U.S. Patent No. 4,238,097 to Clausen et al.

Baru discloses an appendage that is basically the same as that recited in claims 16-19, 23-25, 27, and 29-32 except that the seat connector lacks a second end affixed to the central support column of a chair, as recited in the claims. See Figures 1-7 of Baru for the teaching that an appendage having a monitor support structure 52 (see Fig. 1) including a tray with holes 56,58 (Fig. 7) and a pair of grooved rollers 60,62, a chassis 14 with a first end positioning the monitor support structure and a second end and including a pair of parallel, arcuate, tubular, elongated support rails 18,20 passing through the holes of the tray and engaging the grooved rollers, a seat connector 26,28 with a first end affixed to the second end of the chassis and a second end affixed to a chair 24 and including a bracket with passage holes through which distal ends of the support rails are inserted, at least one spacer 22,50, and a foot pedals 30 on the support rails. Clausen et al. show an appendage similar to that of Baru wherein the appendage has a monitor support structure 40 (see Fig. 1), a chassis 30, a seat connector 52 with an end affixed to a central support column 50 of a chair 12 having a seat and a feet assembly, and a bracket (see Fig. 2) of the seat connector with an opening through which the central support column of the chair passes and a lock mechanism 80,90 that locks the bracket onto the central support column. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the appendage of Baru such that the seat connector's second end

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is affixed to a central support column of the chair, and the seat connector's bracket includes an opening through which the central support column of the chair passes, and a locking mechanism on the seat connector capable of locking the seat connector onto the central support column below a seat and above a feet assembly, such as the appendage disclosed in Clausen et al. One would have been motivated to make such a modification in view of the suggestion in Clausen et al. that the seat connector's bracket connected to the chair's central support column provides a separable chassis and seat connector for easy shipping and packaging.

8. Claims 26, 28, and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baru in view of Clausen et al. as applied to claims 16-25, 27, and 29-32 above, and further in view of U.S. Patent No. 3,606,383 to Mesinger.

Baru, as modified, discloses an appendage that is basically the same as that recited in claims 26, 28, and 33-35 except that the support rails lack helical springs, as recited in the claims. Mesinger shows an appendage similar to that of Baru wherein the appendage has a seat 18 (see Fig. 1), a chassis with a pair of parallel support rails 27,27', helical springs 35,35' on the ends of the support rails, and retaining elements 39 (Fig. 2) holding the helical springs in position. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the appendage of Baru to include helical springs on the ends of the support rails that extend out beyond the seat connector and retaining elements holding the helical springs, such as the appendage disclosed in Mesinger. One would have been



motivated to make such a modification in view of the suggestion in Mesinger that the helical springs providing dampening support of the seat.

### ***Response to Arguments***

9. Applicant's arguments filed 06 February 2006 have been fully considered but they are not persuasive. Applicant argues that the locking mechanism of the seat connector must attach between to the central support column of a chair below the seat and above the feet assembly. Examiner concedes that the instant application disclose on page 11, lines 22-24 that the states the appendage is for retrofitting an office chair around the central support column below the seat and above the feet assembly thereof. However, this recitation merely describes the location of the central support column of the chair and does not describe that the appendage is locked upon a chair that maintains its connections to the feet assembly. Figure 3 and page 12, lines 7-8 of Applicant's specification clearly teach that the feet assembly is removed from the central support column and that the central support column pass through the hole 36 of the seat connector. Moreover, maintaining the feet assembly of the office chair upon association with the appendage would destroy the utility of the appendage. The locking mechanism 40 shown in Figure 4 would be inoperable if a feet assembly were still located on the central support column.

Overall, the recitation of the locking mechanism being for locking the seat connector onto the central support column below the seat and above the feet assembly is a recitation of the intended use of the appendage. A recitation of the intended use of

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the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Herein, the appendages of Chao and Baru are capable of performing the intended use.

The rejection under 35 USC 103(a) drawn toward claims 26, 28, and 33-35 was argued solely on the premise that the cited art does not teach or suggest the appendage recited in amended claim 16, and as a result the above 35 USC 103(a) rejection of claims 26, 28, and 33-35 remains.

Upon consideration of the Applicant's arguments, Examiner maintains the rejections of claims 16-19 and 23-35.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F. Edell whose telephone number is (571) 272-6858. The examiner can normally be reached on Mon.-Fri. 8:30am-5:00pm.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joe Edell  
November 21, 2006



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